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12 **UNITED STATES DISTRICT COURT**
13 **EASTERN DISTRICT OF WASHINGTON**

14 BIRTHRIGHT, a Canadian not-
15 for-profit corporation

16 Plaintiff,

17 vs.

18 BIRTHRIGHT, L.L.C., a
19 Washington State limited liability
20 company,

21 Defendant.
22
23

No.

COMPLAINT FOR TRADEMARK
INFRINGEMENT AND UNFAIR
COMPETITION

1 Plaintiff, Birthright (“Birthright” or “Plaintiff”), by its undersigned
2 counsel, brings this action for trademark infringement and unfair
3 competition against defendant, Birthright, L.L.C. (“Defendant”).

4 I. PARTIES

5 1. Plaintiff, Birthright, is a Canadian not-for-profit corporation,
6 having a place of business at 777 Coxwell Avenue, Toronto, Ontario,
7 Canada M4C 3C6.

8 2. Upon information and belief, Defendant, Birthright, L.L.C., is
9 a Washington limited liability company, having a place of business at
10 127 East Euclid, Spokane, Washington 99207.

11 II. JURISDICTION AND VENUE

12 3. This is an action for trademark infringement and unfair
13 competition arising under the *Lanham Act*, 15 U.S.C. §§ 1051, *et seq.*

14 4. This Court has subject matter jurisdiction of this action
15 pursuant to 15 U.S.C. § 1121, and 28 U.S.C. §§ 1331, 1332, and 1338.

16 5. Venue is proper in the Eastern District of Washington
17 pursuant to 28 U.S.C. § 1391(c).

18 6. Defendant has committed acts of trademark infringement and
19 unfair competition in the nature of trademark infringement in this
20 District and elsewhere in commerce.

III. FACTUAL BACKGROUND

7. Plaintiff is and has been engaged since 1968 through its related companies (chartered Chapters) (collectively, BIRTHRIGHT) in rendering pregnancy counseling services including counseling about pregnancy and childbirth, medical referrals, legal referrals, social services referrals, job counseling and career development counseling throughout the United States.

8. The nature and extent of Birthright's use of its BIRTHRIGHT name and mark can be seen at its website, www.birthright.org, and at the websites of its Chapters.

9. It is customary for chartered Chapters under license from Birthright to have as the dominant element of the marks and names they use, BIRTHRIGHT, as in Birthright of Walla Walla, located at 609 W. Birch St., Walla Walla, Washington 99362.

10. Birthright has taken steps to protect its BIRTHRIGHT mark and has secured U.S. Trademark Registration No. 2,853,169 for such mark for counseling of pregnant women regarding childbirth, health and mental health issues, including pregnancy health issues. Registration No. 2,853,169 is incontestable. A printout of the pertinent information about such registration from the PTO database showing status and title is attached as Exhibit A.

1 11. Birthright has continuously used BIRTHRIGHT as its
2 trademark and trade name in connection with its programs, services and
3 business.

4 12. Birthright's registered trademark BIRTHRIGHT, is
5 inherently distinctive as applied to Birthright's counseling of pregnant
6 women regarding childbirth, health and mental health issues, including
7 pregnancy health issues.

8 13. Birthright's BIRTHRIGHT trademark and name are
9 inherently distinctive of Birthright's programs, services, and business.

10 14. Use of the BIRTHRIGHT mark and name by Birthright has
11 been continuous and commercially significant and substantially
12 exclusive in connection with the services identified in its registration,
13 and related goods and services.

14 15. By virtue of Birthright's continuous use in commerce of its
15 registered mark, BIRTHRIGHT, and of the BIRTHRIGHT mark and
16 name in connection with its programs, services, and business, and the
17 nature and extent of such use, such programs, services, and business,
18 have become favorably known to the relevant trade and public under
19 such mark and name and identify the programs, services, and business
20 of Birthright.

1 23. The services of Defendant under the challenged mark and
2 name are closely related to those rendered under Birthright's registered
3 BIRTHRIGHT mark.

4 24. Defendant's midwifery services offered under the "Birthright,
5 L.L.C." mark and name and Birthright's pregnancy counseling services,
6 including counseling about pregnancy and childbirth, offered under the
7 BIRTHRIGHT mark, are offered to the same and overlapping classes of
8 customers through the same and overlapping trade channels in the same
9 geographic market where they are promoted through the same and
10 overlapping media.

11 25. Defendant's challenged mark and name incorporates the
12 entirety of the registered BIRTHRIGHT mark, and the addition of the
13 generic term, "L.L.C.," which has no trademark significance, does
14 nothing to obviate the likelihood of confusion, mistake, and deception.

15 26. Members of the relevant public and trade are likely to believe
16 and/or assume in error on seeing or hearing Defendant's marks and
17 names in connection with its business and services, that such services
18 are rendered by or under license from, or in affiliation with, the source of
19 the services rendered under Birthright's registered mark.

20 27. Actual confusion has in fact already occurred and come to the
21 attention of Birthright.

1 28. Defendant's use of "Birthright, L.L.C." as a mark and name,
2 violates the rights of Birthright in its registered BIRTHRIGHT mark.

3 29. Birthright cannot control the nature or quality of the services
4 rendered by Defendant under the challenged mark and name and the
5 continued use of such mark and name irreparably damages Birthright
6 and the goodwill it enjoys in its registered mark.

7 30. Defendant's continued use of "Birthright, L.L.C." is willful,
8 intentional, and undertaken and continued in bad faith.

9 31. Birthright (Plaintiff) has no adequate remedy at law.

10 **V. UNFAIR COMPETITION IN**
11 **VIOLATION OF 15 U.S.C. § 1125(a)**

12 32. The allegations of the preceding paragraphs of the Complaint
13 are incorporated herein by reference.

14 33. This is a claim for unfair competition in the nature of
15 trademark infringement in violation of 15 U.S.C. § 1125(a).

16 34. Defendant's "Birthright, L.L.C." mark and name complained
17 of herein is, as used, confusingly similar to the registered BIRTHRIGHT
18 mark and the BIRTHRIGHT marks and names in sound, appearance
19 and commercial impression.

20 35. Such use by Defendant unlawfully exploits the goodwill
21 Birthright enjoys in its registered mark and its marks and names, which
22 feature BIRTHRIGHT as their dominant element, and is likely to cause
23

1 and has caused confusion, mistake, and deception among the relevant
2 public and the trade, as to Defendant's affiliation or association
3 Birthright and with the services rendered and business conducted by
4 Birthright.

5 36. Defendant's "Birthright, L.L.C." mark and name incorporates
6 the entirety of the registered BIRTHRIGHT mark and the
7 BIRTHRIGHT marks and names of Birthright all of which feature
8 BIRTHRIGHT as their dominant element. The addition of generic or
9 geographically descriptive matter does nothing to obviate the likelihood
10 of confusion, mistake, and deception, given that the related services of
11 the parties are provided to overlapping classes of purchasers and are
12 promoted through the same types of media.

13 37. Members of the relevant public and trade are accordingly
14 likely to believe and/or assume in error on seeing or hearing Defendant's
15 mark and name in connection with its services, that such services are
16 rendered by or under license from or in affiliation with the source of the
17 services rendered under Birthright's registered BIRTHRIGHT mark and
18 its other marks and names which feature BIRTHRIGHT as their
19 dominant element.

20 38. Actual confusion has in fact already occurred and come to the
21 attention of Birthright.

1 39. Defendant's use of "Birthright, L.L.C." as a mark and name,
2 violates the rights of Birthright in its registered mark and its other
3 Birthright marks and names which feature BIRTHRIGHT as their
4 dominant element.

5 40. Birthright cannot control the nature or quality of the services
6 rendered by Defendant under the challenged mark and name and the
7 continued use of such mark and name irreparably damages Birthright
8 and the goodwill it enjoys in its registered BIRTHRIGHT mark and
9 other Birthright marks and names, which feature BIRTHRIGHT as their
10 dominant element.

11 41. Defendant's continued use of Birthright as a mark and name
12 and component of a mark and name is willful, intentional, and
13 undertaken and continued in bad faith.

14 42. Birthright (Plaintiff) has no adequate remedy at law.

15 **PRAYER FOR RELIEF**

16 WHEREFORE, Birthright, respectfully requests that this Court:

17 1. Enter judgment in its favor and against Defendant on the
18 Complaint;

19 2. Permanently enjoin and restrain Defendant, its officers,
20 agents, employees and all other persons in active concert or participation
21 with Defendant from:
22
23

1 a. Use of the “Birthright, L.L.C.” mark and name, and any
2 mark or name which contains or comprises BIRTHRIGHT or any
3 phonetic equivalent, in connection with midwifery services or
4 rendering pregnancy counseling services and any related goods and
5 services and business;

6 b. Use of the “Birthright, L.L.C.” mark and name and any
7 mark or name which contains or comprises BIRTHRIGHT or any
8 phonetic equivalent, in connection with any marketing or
9 advertising in connection with midwifery services or pregnancy
10 counseling services including counseling about pregnancy and
11 childbirth, and any related goods or services or business, not
12 limited to marketing or advertising conducted through television,
13 radio, print media, the internet, or other social media; and

14 c. Engaging in any other conduct that causes, or is likely
15 to cause, confusion, mistake, misunderstanding, or deception as to
16 an affiliation, connection, association, origin, sponsorship or
17 approval of Defendant’s business and services, by Birthright or
18 with Birthright’s marks or names;

19 3. Order an accounting against Defendant for all profits received
20 from the rendering of services under any mark and name which contains
21 or comprises “Birthright” or any phonetic equivalent;

1 4. Award Plaintiff its attorneys' fees, costs, and disbursements
2 pursuant to 15 U.S.C. § 1117; and

3 5. Grant such further relief as this Court deems just and
4 appropriate.

5 Respectfully submitted this 6th day of November, 2015.

6
7 By: s/ Geana M. Van Dessel

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17 Counsel for Plaintiff

18 *Motions for admission pro hac vice will be*
19 *submitted*